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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,631	04/14/2005	Anne Costantini	37261P108	8391
8791 7590 09/13/2007 BLAKELY SOKOLOFF TAYLOR & ZAFMAN 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
			EXAMINER MENEZES, MARCUS	
			ART UNIT 3677	PAPER NUMBER
			MAIL DATE 09/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/531,631	Applicant(s) COSTANTINI, ANNE	
	Examiner Marcus Menezes	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- Examiner apologizes for indicating allowability of certain claims in the previous office action. However, Applicant should note that this action does not constitute a final office action.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 13 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the limitation that the transponder is "programmable or not" is indefinite. It must be one or the other. Examiner suggests making the transponder capable of being programmed.

3. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, it is unclear whether "a cylindrical wall" of claim 3 pertains to the sleeve or the upper half shell. Examiner will interpret the cylindrical wall to pertain to the upper half shell.

4. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, it is unclear what constitutes "it" in lines 5 and 6 of the claim. Examiner will interpret "it" to mean the lower half shell.

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5. Claim 5 recites the limitation "lower internal cylindrical wall" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Examiner will interpret this limitation to constitute the lower cylindrical inner wall.

6. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the second line of the claim stating "the lower cylindrical of" is indefinite. Examiner suggests – the lower cylindrical wall of.

7. Claim 10 recites the limitation "the glue" at the end of the claim and "the coil" and "the processor" in the second line of the claim. There is insufficient antecedent basis for these limitations in the claim.

8. Claims 6 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the limitation of a "clear height" is confusing. What constitutes a "clear" height? Examiner will interpret the clear height to the distance between the planar sides of the two half shells. (see figure below).

9. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, it is unclear what is meant by "enclosed within without compression." Examiner suggests placement of an "and" in between within and without.

10. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention. More specifically, the second and third lines of the claim are confusing. The recitation that the internal projection is provided with a projecting peripheral rim is indefinite. Examiner will interpret that the projecting peripheral rim pertains to the lower cylindrical wall and not to the internal projection. Clarification is required.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

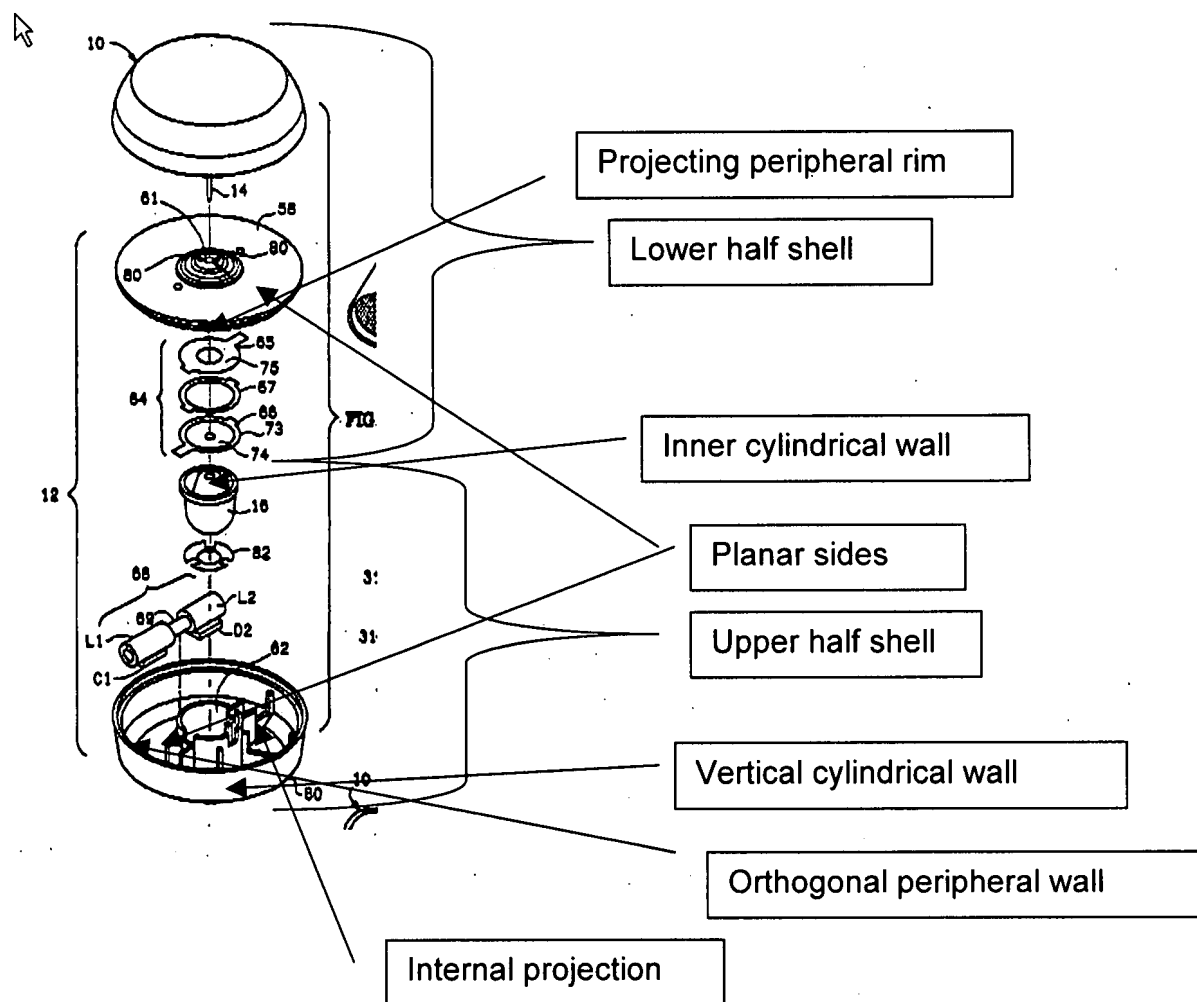
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-7, 10, 12-15, 20, 23-27, 29 and 31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Thurmond et al. (US 5347262, hereinafter "Thurmond").

Thurmond discloses an electronic button tag comprising a programmable transponder (68), (see Summary of the Invention), enclosed in a shell, said shell comprising an open-ended or blind axial transverse passage (61) for a fixing means (10), wherein the shell is made from two half shells namely a lower half shell (or first shell portion) and an upper half shell (or second shell portion), which are capable of being assembled together at a median plane which is disposed transversely to the axial passage opening for the fixing means, and the transponder is enclosed within the two half-shells and enclosed without compression between the two half-shells. (See figure below). Note, the method of assembly, specifically the laser weld limitation, is not

germane to the issue of patentability of the device itself. Therefore, this limitation has been given minimal patentable weight.



Thurmond further discloses that the two half shells are provided with complementary internal and external walls, contributing to their assembly.

Thurmond further discloses that, as best understood by the Examiner, that the upper half shell comprises of a sleeve (62) with a central opening around the median

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axis, wherein a cylindrical wall (16) projects outwards on a planar wall (82) and is extended by an inner cylindrical wall (see above) below said planar wall to connect with a corresponding lower cylindrical wall (74) on the lower half shell, the planar wall (82) of the upper half shell being connected on its periphery to a vertical cylindrical wall (see above) via element 62, connecting it to the lower half-shell.

Regarding claim 4, Thurmond further discloses that the lower half shell comprises of a lower cylindrical inner wall (75) around its median axis corresponding to that of the sleeve of the upper half shell and providing the transverse passage, that the lower half shell is provided with an internal projection (65), that the lower half shell is provided with a projecting peripheral rim (see above) cooperating with the orthogonal peripheral wall of the upper half shell (see above).

Regarding claim 5, Thurmond further discloses that an internal projection (65) is placed between the lower cylindrical inner wall (75) and the peripheral rim.

Regarding claim 6, Thurmond further discloses, as best understood by the Examiner, that the internal projection (65) is of a lesser height than the height (between planar sides of the shells) within the button tag.

Regarding claim 7, Thurmond further discloses that the lower cylindrical wall (74) of the lower half shell has a conical form with an upper shoulder enabling the tip of the punch of a male panel tag to be locked in.

Regarding claims 10,20,23 and 29, Thurmond discloses, as best understood by the examiner, a transponder fixed into position. As for the use of an adhesive, see above rejection regarding the method of assembly or forming of a device.

Thurmond further discloses that the lower half-shell is provide with a peripheral rim which on assembly fits into the external shoulder of the vertical wall of the upper half shell.

Thurmond further discloses that the cylindrical wall (74) of the first shell portion provides a passage for a punch of a male tag, wherein said cylindrical wall of the first shell portion having a conical form and providing a shoulder (73) within the sleeve to enable a top of the punch of male tag to be locked in the sleeve.

Thurmond further discloses an internal projection (see above) that is located between the cylindrical wall (16) and a peripheral rim (rim of the orthogonal peripheral wall) of the second shell portion, the internal projection being of a height less than the distance between the planar walls of the first and second shell portions.

Thurmond further discloses that the two half-shells have substantially a same radius about a median axis.

Response to Arguments

13. Applicant's arguments with respect to the independent claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant should note that claims 8,9,11,17-19,21,22,28 and 30 are all rejected due to dependency of claims with §112 rejections. Proper corrections of said §112

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rejections would make the claims allowable but dependent on rejected independent claims.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcus Menezes whose telephone number is 571-272-6284. The examiner can normally be reached on 8:00am - 5:30pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marcus Menezes
Examiner
Art Unit 3677

MM


Katherine Mitchell
Primary Examiner